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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/710,295
Filing Date: June 30, 2004
Appellant(s): ZUKOWSKI ET AL.

George M. Macdonald (reg. 39284)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 05/04/2010 appealing from the Office action mailed 12/04/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Patent No. US 7089288 B2	Gossweiler et al.	09-1999
Pub. No. US 20050131959 A1	Thorman et al.	12-2003

Published article, "Bridging Physical and Virtual Worlds with Electronic Tags"

Want et al. 1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

Claims 1-6, 13-22, 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gossweiler III et al (Patent No. US 7089288 B2; hereinafter Gossweiler) in view of Thorman et al. (Pub. No. US 2005/0131959 A1; hereinafter Thorman).

As to claim 1, Gossweiler teaches:

A method for processing a physical token in a responsive environment having a processor to provide an association with a virtual document (e.g., see Fig. 1) comprising:

attaching a physical sensor to the physical token, wherein the physical sensor is associated with the physical token (e.g., see 2:9-20, 4:61-67 to 5:1-9; wherein a small inductive coin with an antenna is attached to the tag; the tag cover is associated with the inductive coin and antenna);

sensing the presence of the physical token in an instrumented association bin (e.g., see Fig. 1 and 2:21-38, 5:47-57; communication between tag and tag reader occurs only when both are proximate; wherein the computer system having a plurality of card readers is interpreted as an instrumented association bin; note the card reader is affixed to a computational device included in the computer system);

Gossweiler further teaches associating a document with physical token in response to sensing the presence of the physical token in the instrumented association bin (e.g., see 2:39-55, 5:47-67, 6:14-36 and 6:60-67; wherein the user can be prompted to enter associated parameters via a dialog box or can navigate to the desired location);

Gossweiler further teaches obtaining user selection data identifying the virtual document to register with the physical token (e.g., see 2:39-55, 5:47-67, 6:14-36 and 6:60-67; where a text document can be associated with the identification number of the electronic tag);

Gossweiler teaches creating a sensor model instance associating the physical sensor with the physical token, the user and the virtual document using the processor (e.g., see 2:56-67 to 3:1-47, 6:14-36; 6:60-67; wherein each action is parameterized by a list of (name, value) pairs appropriate for that action, where the action can be linked to particular user, see 3:25-35);

While Gossweiler teaches the ability for the user to identify the virtual document to register with the token (e.g., see 6:14-36 and 6:60-67; wherein the user can easily add new tags and new types of actions; wherein one of the actions can be displaying a text document), Gossweiler does not teach launching a document browser application and obtaining user selection data from the document browser application to register with the token.

Thorman teaches a file browser that allows the user to identify files or documents for further manipulating (e.g., Figs. 4-5 and [0032]; wherein a file browser allow a user to easily identify files and directories). Accordingly, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the feature of allowing the user to identify a document to register with the token taught in Gossweiler to include the file browser feature as taught in Thorman to allow the user to select a document to register using a launching document browser. As suggested by Thorman, one would have been motivated to make such a combination is to make easier for the user to identify files or documents for further manipulating; thus, reduce the amount of time it takes the user to identify a document (e.g., see Thorman [0032]).

As to claim 15, Gossweiler teaches:

A method for processing a physical token in a responsive environment having a processor to provide an association with a virtual document (e.g., see Fig. 1) comprising:

placing a physical sensor having a sensor identifier in proximity to the physical token, wherein the physical token is associated with the physical token (e.g., see 2:9-20, 4:61-67 to 5:1-9; wherein a small inductive coin with an antenna is attached to the tag; the tag cover is associated with the inductive coin and antenna; and wherein the coin or transponder includes an ID number);

placing the physical token in an instrumented association bin (e.g., see Fig. 1 and 2:21-38, 5:47-57; communication between tag and tag reader occurs only when both are proximate; wherein the computer system having a plurality of card readers is interpreted as an instrumented association bin; note the card reader is affixed to a computational device), wherein the instrumented association bin is configured to read the physical sensor (e.g., see 2:21-38, 5:47-57; wherein the tag reader included in the computer system can read the tag's information);

obtaining sensor identifier data from the instrumented association bin (e.g., 2:21-38; wherein the tag reader receives the identification number and passes this on to the computer system as an ASCII string);

Gossweiler further teaches obtaining user selection data identifying the virtual document to register with the token (e.g., see 2:39-55, 5:47-67, 6:14-36 and 6:60-67; where a text document can be associated with the identification number of the electronic tag);

Gossweiler teaches creating a sensor model instance associating the physical sensor with the physical token, the user and the virtual document using the processor (e.g., see 2:56-67 to 3:1-47, 6:14-36; 6:60-67; wherein each action is parameterized by a

list of (name, value) pairs appropriate for that action, where the action can be linked to particular user, see 3:25-35);

While Gossweiler teaches the ability for the user to identify the virtual document to register with the token (e.g., see 6:14-36 and 6:60-67; wherein the user can easily add new tags and new types of actions; wherein one of the actions can be displaying a text document), Gossweiler does not teach launching a document browser application and obtaining user selection data from the document browser application to register with the token. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have made this combination for the same reasons as set forth in the rejection of claim 1.

As to claims 2 and 16, Gossweiler further teaches setting a sensor name property (e.g., see 5:47-57, 6:14-36).

As to claims 3 and 17, Gossweiler further teaches setting the sensor name property using an identifier associated with the document (e.g., see 5:58-67 to 6:1-13, 6:60-67).

As to claims 4 and 18, Gossweiler further teaches setting a sensor type property to indicate a physical sensor (e.g., see 6:60-67 to 7:1-13).

As to claims 5 and 19, Gossweiler further teaches setting a sensor class property to indicate touch detection (e.g., see 6:60-67 to 7:1-13).

As to claims 6 and 20, Gossweiler further teaches the physical sensor is attached to the physical token (e.g., see 2:9-20, 4:61-67).

As to claims 13 and 21, Gossweiler further teaches wherein the physical token comprises a card (e.g., see 2:9-20; the tag) and sensing the presence of the physical token in an instrumented association bin comprises placing the card and the physical sensor in the instrumented association bin (e.g., see Fig. 1 and 2:21-38, 5:47-57; communication between the electronic tag and tag reader occurs only when both are proximate; the card reader is affixed to a computational device in a computer system. The electronic tag comprises a card and coin unit with antenna).

As to claims 14 and 22, Gossweiler further teaches before placing the card and the physical sensor in the instrumented association bin, attaching the physical sensor to the card (e.g., see 2:9-20, 4:61-67 to 5:1-9; wherein a small inductive coin with an antenna is attached to the tag; the tag cover is associated with the inductive coin and antenna; and wherein the coin or transponder includes an ID number).

As to claims 25 and 26, Gossweiler further teaches a plurality of physical tokens, wherein each of the plurality of physical tokens is each associated with one of a plurality of virtual documents (e.g., see 6:14-36).

Claims 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gossweiler in view of Thorman further in view of Want et al. (published article, "Bridging Physical and Virtual Worlds with Electronic Tags"; CHI' 99; pages 370-377; hereinafter Want).

As to claim 23, Gossweiler and Thorman teach the limitations of claim 15 for the same reasons as set forth above. Gossweiler further teaches wherein the sensor identifier comprises an first tag and the instrumented association bin comprises a tag reader, further comprising reading the sensor identifier data from the first tag using the

tag reader (e.g., see 1:55-67 to 2:1-55; 5:47-57). Gossweiler and Thorman do not teach RFID tag and RFID reader.

In the same field of endeavor of physical and virtual worlds using electronic tags, Want teaches RFID tag and RFID reader (e.g., see pages 371, 372). Accordingly, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the electronic tag and tag reader as taught by Gossweiler and Thorman to include the feature of the RFID tag and RFID reader of Want to achieve the claimed invention. As suggested by Want, one would have been motivated to make such a combination is because RFID tags has no on-board power, thereby reducing the size and weight of the individual tags and eliminating maintenance requirements (e.g., see Want page 371, right column, "SYSTEM OVERVIEW").

(10) Response to Argument

A) The appellants argue that the cited references do not alone or in any proper combination render obvious the claims as presently recited. Specifically, the appellants argue that the cited portions of the references do not teach or suggest such a physical sensor associated with the user and a physical token (see the Brief pages 10)

In response, the examiner respectfully disagrees. Gossweiler discloses using an electronic identification tag to associate with virtual document such that the user can command to open a virtual document (e.g., see Fig. 1 and col. 6, lines 14-36, 60-67). As seen in Figure 1, there is clearly shown an association between the electronic tag having the physical sensor and a physical token (e.g., a small inductive coin attached to a tag, see col. 2 lines 9-20) with a virtual document (e.g., see Fig. 1 and col. 6, lines 14-36; document 64). The association between the electronic tag and the virtual document is

done through the tag identification number (e.g., see Example Table on col. 9 lines 40-50 and col. 2 lines 39-55 and col. 5 lines 58-67).

Gossweiler further teaches the tag identification number can be defined by a user such that the user can provide unique identification numbers and/or supply additional data for immediate association with the tag (e.g., see col. 5 lines 49-51). The tag identification number is associated with the personal identification number that is used to link to commands such as "display a graphical image on a computer display", or "begin logging on to a computer network" (e.g., see col. 6 lines 60-67; personal identification number). In this case, each record in the database reads on a sensor model instance having a tag identification number and is associating with a virtual document (e.g., see Example Table on col. 9 lines 40-50 and col. 2 lines 39-55 and col. 6 lines 60-67). The tag identification number is further associated with the user-defined or user personal identification number (e.g., see col. 5 lines 49-51 and col. 6 lines 60-67). For at least these reasons, the examiner concludes that Gossweiler teaches the limitation of "creating a sensor model instance associating the physical sensor with the physical token, the user and the virtual document".

B) The appellants argue that the cited portion of the reference relied on at Gossweiler col. 3 lines 25-27 requires a separate tag to identity the user wherein it states "reading a first tag embedded in a picture identification card to establish user identification, immediately presenting a second tag…" (see the Brief pages 11, paras 1, 2).

In response, the examiner notes the cited portion of the Gossweiler refers to the capability of executing complex instructions sequences and information from one or more electronic tags to a reader connected to a computer (e.g., see col. 3 lines 11-14). The specific example where complex instructions sequences requires more than one

tags is just one example and it does not exclude the capability of executing the complex instructions sequences and information using just one tag. In addition, the claim language does not limit to only one tag. The fact that a sentence of commands includes commands such as a command to establish authentication using user identification from a tag embedded in a picture identification card and a command to open my computer desktop as I saved it a week ago (e.g., see col. 3 lines 25-35) clearly shows an association between user information with the later command in this case "open my computer desktop as I saved it a week ago". However, the later command such as "open my computer desktop as I saved it a week ago" is only one user-defined example, Gossweiler teaches that the commands are user-defined and can include command such as open a particular virtual document (e.g., see col. 3 lines 1-10, col. 6 lines 14-36 and lines 60-67). The skilled artisan would appreciate that the user information is associated with the later command such as open a particular virtual document because Gossweiler suggests that a command included in a sentence can be directed to a particular document (e.g., see col. 3 lines 1-10).

C) The appellants argue that the examiner using improper inherency argument (see the Brief pages 11, paras 4, 5).

In response, the examiner directs the appellants to the bottom of page 8 of the 12/04/2009 Final Office action, the examiner does not use the term such as "inherent" or "must"; therefore, the argument that the examiner using improper inherency argument is not applicable.

D) The appellants argue that the combination of Thorman and Gossweiler is not proper because it would create a seemingly inoperative device (see the Brief pages 12, para 3).

In response, the examiner respectfully disagrees and directs the appellants to MPEP §2121.01(II) that "Even if a reference discloses an inoperative device, it is prior art for all that it teaches." *Beckman Instruments v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989). Therefore, "a non-enabling reference may qualify as prior art for the purpose of determining obviousness under 35 U.S.C. 103." *Symbol Techs. Inc. v. Opticon Inc.*, 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991). The fact that Thorman discloses a user interface that displays files/documents from a plurality of locations in a single window and that the different files may have the same names does not prevent the user from selection a document and file for further manipulating (e.g., see Fig. 7) because the computer will treats those as if they are different files because they are in different locations (e.g., see the evidently support attached herewith; Note: this reference is not used to support the rejection, but is purely to support the examiner's response).

In this case, Gossweiler teaches the limitations of claim 1 as set forth above. Gossweiler teaches: launching a document application in response to sensing the presence of the physical token in the instrumented association bin (e.g., see Fig. 1 and col. 2 lines 21-55; launching a dialog box in response to receiving identification number when the tag is proximate to the tag reader). Gossweiler further teaches obtaining user selection data identifying the virtual document to register with the physical token (e.g., see col. 2 lines 39-55, col. 6 lines 14-36, 60-67; where a text document can be associated with the identification number of the electronic tag). While Gossweiler suggests to the skilled artisan that the document application (e.g., dialog box) is for the

user to select the virtual document to register with the physical token (e.g., see col. 2 lines 48-55 and col. 6 lines 14-36), Gossweiler does not teach the document application (e.g., dialog box) is a document browser application as seen in the conventional document/file browser application as evidently shown by Thorman; wherein Thorman teaches a file browser application that allows the user to select a file or a document for further manipulating (e.g., see Figs. 4-5 and [0032]; wherein a file browser allows the user to easily identify files and directories). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have included a user-friendly graphical user interface document browser application of Thorman in the command like interface document application (e.g., dialog box) of Gossweiler to achieve an improved system having a GUI-based document browser interface to make it easier for the user to select files/documents; thus reduce the amount of time it takes the user to identify a document (e.g., see Thorman [0032]). For at least these reasons, the examiner concludes that the combination of Gossweiler and Thorman would create an improved device of a more user friendly document browser application over the command like dialog box of Gossweiler alone.

E) With respect to claims 15 and 23, the appellants argue that the combination of Thorman and Gossweiler does not teach the limitations as claimed for the same reasons presented in claim 1 (see the Brief pages 13, 14).

These arguments have been addressed as set forth in the responses A-D and are incorporated herein.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/TuyetLien T Tran/
Examiner, Art Unit 2179

Conferees:

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